UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/248,160	02/09/1999	RICHARD W. CHESTON	RP9-98-096	8471

42640	7590	01/07/2005

DILLON & YUDELL LLP
8911 NORTH CAPITAL OF TEXAS HWY
SUITE 2110
AUSTIN, TX 78759

EXAMINER
DURAN, ARTHUR D

ART UNIT	PAPER NUMBER
3622	

DATE MAILED: 01/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

MAILED

JAN 0 7 2005

GROUP 3600

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 12/28/04

Application Number: 09/248,160
Filing Date: February 9, 1999
Appellant(s): Cheston, Richard

Andrew J. Dillon
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 10/18/04.

(1)   ***Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

(2)   ***Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or

be directly affected by or have a bearing on the decision in the pending appeal is contained in the

brief.

(3)   ***Status of Claims***

The statement of the status of the claims contained in the brief is correct.

(4)   ***Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in

the brief is correct.

(5)   ***Summary of Invention***

The summary of invention contained in the brief is correct.

(6)   ***Issues***

The appellant's statement of the issues in the brief is correct.

(7)   ***Grouping of Claims***

The appellant's statement that the claims of the groups stand or fall together is correct.

(8)   ***Claims Appealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

The following is a listing of the prior art of record relied upon in the rejection of claims

under appeal.

EP 601 500 A1	Stringer	6-1994
6,530,019	Carroll	3-2003
5,155,680	Wiedemer	10-1992
6,243,745	Casey	6-2001

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 12-13, 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Stringer, EP 601,500 in view of Carroll, patent number 6,530,019.

Stringer teaches a personal computer system with usable software comprising: a

processor, a storage device and programs loaded on the storage device in such a way as to make

the programs unusable (col. 5, lines 35-45, col. 13, lines 25-35, 50-55, col. 14, lines 5-10, 15-25,

col. 9, lines 3-10); a module associated with the processor for selecting certain of the programs

loaded on the pc including a user input which can add or delete programs from a listing of

programs which are appropriate for that user (col. 15, lines 4-5, 15-20, 40-45); a module

associated with the processor and responsive to the selecting of programs to make the selected

programs active and usable (col. 10, lines 25-30, col. 11, line 50 – col. 12, line 25); and a module

associated with the processor to make the programs which were not selected permanently

unusable including erasing from the storage device the programs not selected (col. 14, lines 39-

40, col. 16, lines 1-5).

Carroll teaches a processor, storage device, and programs loaded on the storage device in such a way as to make the programs unusable (col. 3, line 60 – col. 4, line 15, col. 2, lines 20-25).

It would have been obvious to one having ordinary skill in the art at the time of the invention to have made the programs of Stinger entirely unusable since this would have been adopted for the intended use of requiring acceptance of a software contract, in this case informing the user of limitations of the trial version, and/or enforcing payment if the trial version is not free. Alternatively, it would have been obvious to have the selection of desired programs as in Stinger in the system of Carroll since this would have been adopted for the intended use of limiting costs to only those programs that are desired by the user and/or would have allowed the user to save space on his/her system as taught by Stinger.

Additionally, to the extent that the software is encrypted and of limited functions, where full use is not permitted, and is only fully usable upon payment and receiving the code, Stringer teaches pre-loading unusable software. The limited functions could be so limited that only a view of the software is provided (animated demonstration), but, overall, cannot be used as is known in the software art (Stringer, col. 3, lines 37-45). The difference lies in the degree of functionality chosen by the software developers.

Carroll teaches the need for enforcing and verifying software contracts and/or copyright agreements where the software is disabled until the user agrees to a software contract. Given the scale of what can be considered as usable or unusable, Carroll shows the desire of placing software protection above a limited trial basis to software developers thereby establishing a motive for making the software entirely unusable in Stringer.

Carroll teaches the need and desire to protect the software from pirating. Considering the

combination with Stringer, this can be accomplished by fully encrypting the original version.

Alternatively, it would have been obvious to have the selection of desired programs as in Stinger

in the system of Carroll since this would have been adopted for the intended use of limiting costs

to only those programs that are desired by the user and/or would have allowed the user to save

space on his/her system as taught by Stinger.

Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stringer, EP

601 500 in view of Carroll as above, further in view of Wiedemer, patent number 5,155,680.

Stringer teaches a method of installing a variable selection of software programs

comprising: loading onto the personal computer storage a plurality of software programs in

unusable form (col. 5, lines 35-45, col. 13, lines 25-30, 50-5, col. 14, lines 5-10, 15-25); selecting

the programs which are needed for the pc (col. 15, lines 4-5, 15-20, 40-45); converting from

unusable form into usable form the programs which have been selected (col. 10, lines 25-30, col.

11, line 50 – col. 12, line 25); storing the converted programs in usable form in the pc (col. 11,

lines 15-20, col. 8, lines 25-30); and paying royalties only on programs which have been selected

(col. 13, lines 35-45). Stringer also teaches a method of loading each computer with the superset

of programs, each being in unusable form (original version unusable col. 13, lines 20-35, col. 6,

lines 35-40, col. 15, lines 1-5, 15-25), selecting the subset of programs which are appropriate for

the given computer and converting the programs into usable form and storing them on the

hardfile of the personal computer (col. 13, lines 40-45, col. 11, lines 5-15, col. 11, line 50 – col.

12, line 25). Stringer also teaches erasing software programs that were not selected (col. 15,

lines 15-20). While Stringer teaches paying royalties only on programs which have been

selected and subsequently converted and stored, Stringer does not show paying after selection,

conversion, and storing in usable form.

Carroll teaches a processor, storage device, and programs loaded on the storage device in

such a way as to make the programs unusable (col. 3, line 60 – col. 4, line 15, col. 2, lines 20-

25).

It would have been obvious to one having ordinary skill in the art at the time of the

invention to have made the programs of Stinger entirely unusable since this would have been

adopted for the intended use of requiring acceptance of a software contract, in this case

informing the user of limitations of the trial version, and/or enforcing payment if the trial version

is not free. Alternatively, it would have been obvious to have the selection of desired programs

as in Stinger in the system of Carroll since this would have been adopted for the intended use of

limiting costs to only those programs that are desired by the user and/or would have allowed the

user to save space on his/her system as taught by Stinger.

Wiedemer teaches a billing method which would include payment after selection,

conversion, and storage in usable form (see at least col. 4, lines 64 – col. 5, line 5, col. 6, lines

50-55, col. 8, lines 25-50).

It would have been obvious to one having ordinary skill in the art at the time of the

invention to have implemented the billing method of Wiedemer where applications are first

deciphered in the system of Stringer since the billing of Wiedemer would have offered

convenience to the user of Stringer where one payment can be made at one time for the list of

software converted rather than repeated payments for each code number of Stringer.

Claims 1-2, 4-6, 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Stringer and Carroll as above, further in view of Casey et al., patent number 6,243,745.

Stringer teaches a personal computer system initially loaded with software including

selected and non-selected software in unusable form (original version unusable col. 13, lines 20-

35, col. 6, lines 35-40, col. 15, lines 1-5, 15-25), with the selected software later converted and

loaded thereon in usable form (col. 13, lines 40-45, col. 11, lines 5-15, col. 11, line 50 – col. 12,

line 25), the computer including a processor, a storage device coupled to the processor for

storing programs therein (col. 13, lines 20-55), with selected programs stored in the storage

device in usable form after conversion from unusable form having been converted by the

processor from unusable form and stored in usable form with non-selected programs not being

converted into usable form and creating a list of the selected software for paying royalties on

only the selected software (col. 10, lines 25-30, col. 13, lines 20-50, col. 15, lines 40-45).

Stringer also teaches the processor includes a software module which erases the non-selected

software to remove it from the computer (col. 15, lines 15-25); the computer includes a software

module for converting the selected software from an encrypted form into an unencrypted form

(col. 6, lines 35-40, col. 11, lines 20-32) and the list of selected software upon which a royalty is

paid includes the software which is converted from encrypted to unencrypted form (col. 15, lines

1-10).

Carroll teaches a processor, storage device, and programs loaded on the storage device in

such a way as to make the programs unusable (col. 3, line 60 – col. 4, line 15, col. 2, lines 20-

25).

It would have been obvious to one having ordinary skill in the art at the time of the invention to have made the programs of Stinger entirely unusable since this would have been adopted for the intended use of requiring acceptance of a software contract, in this case informing the user of limitations of the trial version, and/or enforcing payment if the trial version is not free. Alternatively, it would have been obvious to have the selection of desired programs as in Stinger in the system of Carroll since this would have been adopted for the intended use of limiting costs to only those programs that are desired by the user and/or would have allowed the user to save space on his/her system as taught by Stinger.

Casey teaches selecting programs based on the user's position, or function, and requirements (col. 6, lines 35-40, col. 7, lines 35-45).

It would have been obvious to one having ordinary skill in the art at the time of the invention to have selected programs based on the user's position and requirements as in Casey in the system of Stringer, for example, as an option in the order entry window of Stringer, since selecting programs based upon the user's position and requirements would have been adopted for the intended use of providing a procedure which offers time saving advantages of automatically activating needed programs over the individual activation of each program needed of Stringer. It also would have been obvious to have deleted applications unrelated and unneeded to the user's function since this would have saved space on the user's computer as taught in Stringer. It also would have been obvious to have converted the selected software from a compressed form to an uncompressed form since this is well known in the art for saving disk space and since saving disk space is an advantage addressed in Stringer.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stringer and

Carroll in view of Casey et al. as applied to claim 1 above, and further in view of Wiedemer,

patent number 5,155,680.

Wiedemer teaches a list of selected software upon which a royalty is paid is the software

which is converted from unusable to usable form (see at least col. 4, lines 64 – col. 5, line 5, col.

6, lines 50-55, col. 8, lines 25-50).

It would have been obvious to one having ordinary skill in the art at the time of the

invention to have implemented the billing method of Wiedemer where applications are first

deciphered in the system of Stringer/Casey since the billing of Wiedemer would have offered

convenience to the user of Stringer where one payment can be made at one time for the list of

software converted rather than repeated payments for each code number of Stringer.

Claims 9-11, 16-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Stringer and Carroll in view of Wiedemer as applied to claims 7-8 above, and further in view of

Casey et al., patent number 6,243,745.

Casey teaches selection of software including identifying the user of the computer (fig. 7,

col. 7, lines 35-37), identifying the job function of the user and selecting software that is

appropriate for the job function (col. 6, lines 35-40, col. 7, lines 35-45).

It would have been obvious to one having ordinary skill in the art at the time of the

invention to have selected programs based on the user's position and requirements as in Casey in

the system of Stringer, for example, as an option in the order entry window of Stringer, since

selecting programs based upon the user's position and requirements would have been adopted for

the intended use of providing a procedure which offers time saving advantages of automatically

activating needed programs over the individual activation of each program needed of Stringer. It

also would have been obvious to have listed the software for the user and his job function for

selection since this would have been adopted for the intended use of customization while

providing the advantage of limiting choices of software desired for designated users.

(11)   ***Response to Argument***

On page 11 of the Appellant's Appeal Brief filed 10/18/04, Appellant states,

"Primary references relied upon by the Examiner either teach the loading of software in a fully

functional evaluation mode onto each computer or a technique whereby none of the software on

a computer is usable until the user has agreed to selected terms and conditions." Appellant's

arguments concerning the claims focus on whether the combination of Stringer and Carroll

discloses these features. Hence, the Response to Arguments below will focus on how Stringer

and Carroll disclose these features.

Examiner notes that while specific references were made to the prior art, that a 35 USC

103(a) rejection was made and that it is the prior art in its entirety and the combination of the

prior art in its entirety that is being referred to.

In response to applicant's arguments against the references individually, one cannot show

nonobviousness by attacking references individually where the rejections are based on

combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re*

Merck & Co., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Also, Examiner notes that Stringer discloses several manifestations of his invention in his disclosure. And, demonstrating that one specific section of Stringer does not disclose a set of features does not prevent a different section of Stringer from disclosing that set of features.

On page 7 the Appellant states, "Stringer expressly teaches that all forms of software loaded within the system are active and fully useable...".

However, Stringer also discloses that he software can be provided as not fully functional or not fully useable. Stringer states that the software can be function limited (col 4, lines 25-30) and that the software can be limited by disabling 'one or more parts' or by not being able to save or restore work or by placing beeps or other noise into the software (col 6, lines 45-55).

Also, Stringer discloses that a user is provided a software product that is unuseable until the user or enters specific validation or authorization responses (col 2, lines 49-55).

Therefore, while Appellant states, "Primary references relied upon by the Examiner either teach the loading of software in a fully functional evaluation mode onto each computer", Stringer discloses that the software can be provided with 'one or more parts' disabled and also that the software can be provided but in an unuseable manner that requires enbabling or authorizing.

In response to Appellant's other statement that, "...or a technique whereby none of the software on a computer is usable until the user has agreed to selected terms and conditions", Examiner notes that this statement refers to the Carroll reference. Examiner notes that the Carroll reference was added to more clearly demonstrate that software can be made unuseable before being selected for use. That is, Stringer already discloses that different versions or a variety of computer software are preinstalled on a computer and that the software of interest is

selected for purchase (col 5, lines 35-45; col 13, lines 30-50). The Carroll reference was added to demonstrate that the software can be made unuseable before being selected for use. Also, as noted in the Response to Arguments above, Stringer already discloses that 'one or more parts' of software can be disabled and also that the software can be provided in a disabled form until the software is selected and then enabled or authorized. The Carroll disclosure renders obvious that Stringer's disabled 'one or more parts' can be extended such that all the parts of the software can be disabled.

On page 7 the Appellant states, "Consequently, any attempt at a combination of Carroll and Stringer does clear violence...".

In response to applicant's argument that the combination would do clear violence, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Please note that Stringer (col 17, lines 17-25) and Carroll (col 4, line 65-col 5, line 12) disclose much flexibility in implementation of their inventions. Also, as to how it would be obvious to one skilled in the art that based on Stringer's disclosure preloaded software can be made unuseable until the software is selected, please see prior paragraphs and comments in this Response to Arguments section.

For the above reasons, it is believed that the rejections should be sustained.
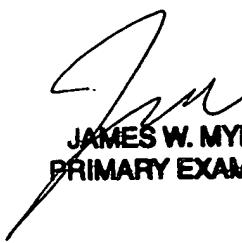
Respectfully submitted,

A D

December 28, 2004

Conferees:

Eric Stamber

James Myhre

JAMES W. MYHRE
PRIMARY EXAMINER

DILLON & YUDELL LLP
8911 N. Capital of Texas Highway
Suite 2110
Austin, Texas 78759